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Remarks

In response to the Examiner's action dated May 24, 2004, Applicant provisionally elects with traverse the claims of Group I (claims 1-10). However, as explained in detail below, the restriction requirement is submitted to be improper (I) because the Examiner has failed to establish a *prima facie* case for restricting the claims, and (II) because it would not be a serious burden for the Examiner to examine the entire application on the merits without the Restriction Requirement.

I. THE EXAMINER HAS FAILED TO ESTABLISH A *PRIMA FACIE* CASE FOR RESTRICTING THE CLAIMS

Original claims 1-20 are pending.

The Examiner is requiring restriction of the claims to one of the following claim sets: Group I (claims 1-10); and Group II (claims 11-20).

In support of this restriction requirement, the Examiner has asserted that:

> The inventions are distinct, each from the other because of the following reasons:
>
> 2.   Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a wireline interactive voice response (IVR) system. See MPEP § 806.05(d).
>
> 3.   Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a wireless short messaging system (SMS). See MPEP § 806.05(d).

In the above analysis, however, the Examiner has mischaracterized the proper standard for determining distinctness of inventions. In particular, the Examiner's assertion that "subcombinations are distinct from each other if they are shown to be separately usable" is not correct. Rather, MPEP § 806.05(d) recites that (emphasis added):

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> Two or more claimed subcombinations, disclosed as usable
> together in a single combination, and which can be shown to be
> separately usable, are <u>usually</u> distinct from each other.

Under MPEP § 806.05(d), "one-way distinctness is required" to the Examiner's Restriction Requirement. To demonstrate one-way distinctness (MPEP § 806.05(d); emphasis added):

> The examiner must show, by way of example, that one of the
> subcombinations has utility other than in the disclosed
> <u>combination</u>.

The Examiner has failed to identify the "single combination" in which the inventions of Groups I and II are disclosed as being usable together. The only "combination" disclosed in the application that appears to apply is the global communication network 18 shown in FIGS. 1 and 2. In his incomplete analysis, the Examiner has only shown examples in which the "subcombinations" are "separately usable" from each other. The Examiner, however, has failed to show that one of the "subcombinations" has utility other than in the disclosed combination, as required under MPEP § 806.05(d). To this end, the Examiner must show that one of the "subcombinations" has utility other than in a global communication network.

For at least these reasons, the Examiner's asserted reasons for requiring restriction between claim Group I and claim Group II do not support the Restriction Requirement and, therefore, the Restriction Requirement should be withdrawn.

II.   IT WOULD NOT BE A SERIOUS BURDEN FOR THE EXAMINER TO EXAMINE THE ENTIRE APPLICATION ON THE MERITS

MPEP § 803.01 provides that (emphasis added):

> If the search and examination of an entire application can be
> made without serious burden, the examiner <u>must</u> examine it on
> the merits, even though it includes claims to independent or
> distinct inventions.

Claim 1 is the only independent claim in Group I and claim 11 is the only independent claim in Group II. Independent claim 11 differs from independent claim 1 only by the substitution of the word "wireless" for the word "voice". In order to fully search and examine the claims of Group 1, the Examiner will have to search for prior art teaching or

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suggesting the following combination of features (features that are shared by both
independent claims 1 and 11):

> an access module configured to expose
> messaging/collaboration data stored on a
> messaging/collaboration server; and
>
> an interface module configured to translate
> messaging/collaboration service requests from a device for
> presentation to the access module and to translate a requested
> messaging/collaboration service deliverable from the access
> module for presentation to the device.

Thus, a full and complete examination of the claims of Group I requires a search and
examination of this shared combination of features. The same search and examination is
required for a full and complete examination of the claims of Group II. Since the differences
between claim Groups I and II can be accommodated simply by replacing the word "voice"
with "wireless" in a keyword-based prior art search, there would not be any serious burden on
the Examiner to complete a search and examination of the claims of Groups I and II at the
same time. Indeed, the subject matter of claim Group I and the subject matter of claim Group
II both are disclosed as being implemented by service modules that are executed on server
computers. In addition, the subject matter of claim Group I and the subject matter of claim
Group II overlap because they both are usable with cellular telephones, which are wireless
voice devices. Thus, the same overlapping search of prior art could be used to examine the
claims of Groups I and II.

The Examiner's classification of the subject matter of Groups I and II into separate
classes is not dispositive of the issue of the burden on the Examiner to search and examine
the entire application. In particular, the Examiner's classification of claim Groups I and II
into separate classes is based only on the differences between the groups of claims (i.e., voice
interface module verses wireless interface module). Such classifications, however, ignore the
bulk of the features of each of the claim groups (namely, an access module configured to
expose messaging/collaboration data and an interface module configured to translate
messaging/collaboration service requests and deliverables). For example, the classification
704/270.1 relates to subject matter that employs speech recognition or synthesis to control or
to provide user feedback such that the processing of speech data may occur at various levels
within a computer network. Although the subject matter of the claims of Group I relates

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tangentially to the subject matter of this classification, none of the claims of Group I specifically recites features relating to speech recognition or synthesis. Similarly, the classification 455/414.4 relates to modulated carrier wave communications not elsewhere classifiable, including a switching, connection, or control function additional to those necessary to establish and maintain a single call connection between two stations, and modification of the format of received or transmitted data unrelated to a call between stations. Although the subject matter of the claims of Group II relates tangentially to the subject matter of this classification, none of the claims of Group II specifically recites features relating to a switching, connection, or control function or relating to a modification of the format of received or transmitted data.

The substantial degree of incongruity between claim Groups I and II and the subject matters of the Examiner's classifications for these groups suggests that these classifications are not the correct classifications for a full and complete search and examination of either of these claim Groups. Accordingly, these different classifications cannot be used to infer that a serious burden would be imposed on the Examiner to search and examine the entire application.

For the reasons explained above, it would not be a serious burden for the Examiner to search and examine all of the claims in the application on the merits, regardless of whether the application includes claims that are independent and distinct.

III.   CONCLUSION

For at least the reasons explained above, Applicants request that the Examiner reconsider and set aside the Restriction Requirement dated May 24, 2004.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

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Respectfully submitted,

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